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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,398	09/19/2003	Douglas S. Ransom	6270/126	9324

46260 7590 04/22/2010
BRINKS HOFER GILSON & LIONE/PML
PO BOX 10395
CHICAGO, IL 60610

EXAMINER

VON BUHR, MARIA N

ART UNIT	PAPER NUMBER
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2121

MAIL DATE	DELIVERY MODE
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04/22/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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(For Applicant)

MAILED

APR 22 2010

Gerald E. Hespos
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New York, NY 10016

(Courtesy Copy)

CENTRAL REEXAMINATION UNIT

In re Application of:	:	DECISION GRANTING
Douglas S. Ransom et al.	:	PETITION TO REPLACE
Application No. 10/666,398	:	PROTECTED DOCUMENT
Filed: September 19, 2003	:	SUBMITTED AUGUST 11, 2009
Attorney Docket No.: 6270-126	:	WITH REDACTED VERSION

This is a decision on applicant's April 9, 2010 petition paper entitled "Petition to Return and Replace Paper Pursuant to 37 C.F.R. §1.182" (the "Petition") and applicant's April 14, 2010 paper entitled "Supplement to Petition to Return and Replace Paper Pursuant to 37 C.F.R. §1.182." The decision also addresses a third party's (E.I. Electronics) December 22, 2009 paper entitled "Petition under 37 C.F.R. 1.183."

The papers are before the Office of Patent Legal Administration.

The petition is **granted**. The redacted form of the Bingham report filed April 9, 2010, and the substitute form PTO-1449 reflecting the redaction are accepted for entry into the present application. The version of the Bingham report (subject to protective order) submitted August 11, 2009 and the accompanying form 1449 are being **expunged** from the record of the application.

FEES

The petition fee of \$400 pursuant to 37 CFR 1.17(f) for the April 9, 2010 petition under 37 CFR 1.182 was charged on April 9, 2010.

The petition fee of \$400 pursuant to 37 CFR 1.17(f) for the December 22, 2009 petition under 37 CFR 1.183 was charged to third party's Deposit Account No. 03-1030, as authorized on page 3 of the petition.

DECISION

On August 11, 2009, applicant filed an information disclosure statement (IDS) which cited and provided a copy of a document referred to as the “Bingham Report” and denoted as item J91 on an accompanying form PTO-1449.

On December 22, 2009, third party E.I. Electronics filed a paper entitled “Petition under 37 C.F.R. § 1.183” requesting the expungement of pages 57-71 of the Bingham report. To support its request, E.I. Electronics provided a copy of a decision by the United States District Court for the Northern District of Illinois, Eastern Division issued December 14, 2009. The December 14, 2009 decision granted relief from asserted violations of a protective order that had been issued in the ongoing litigation¹ between the assignee (Square D Company) of the present application and E.I. Electronics and directed that the above-mentioned document be expunged from a list of Office proceedings. - including the present 10/666,398 application.

As an initial matter, it is noted that the petition of the litigation defendant is not entitled to entry under the rules – see 37 CFR § 1.99, 1,291, and 1.292. The litigation defendant failed to suggest any provision of the regulations which could provide a basis for entry of its petition, and the Office can identify none. Thus, by rule, the litigation defendant, E.I. Electronics, is not entitled to consideration of the December 22, 2009 petition. Pursuant to 37 CFR 1.183, however, “[i]n an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director’s designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed.” In the present instance, the December 22, 2009 petition stated at pages 2-3 that the December 14, 2009 court order (attached as Exhibit C to the December 22, 2009 petition under 37 CFR 1.183) directs the Office to expunge pages 57-71 of the Bingham Report from all Office records, and specifically mentions the instant application. In order to comply with the court order to protect the rights of the litigation defendant, the interests of justice require that the application entry right rules be *sua sponte* waived, and the Office is waiving the rules in order to enter and consider the litigation defendant’s petition paper. The petition paper was presented solely to assert the third party’s rights in protecting the confidentiality of its materials and in no way deals with the merits of the present application.

On April 9, 2010, applicant, in order to comply with the court order, filed a petition requesting expungement from the record, without consideration by the examiner, of pages 57-71 of a document that was submitted as part of a August 11, 2009 information disclosure statement, and denoted as J91 on the accompanying form PTO-1449. Applicant proposed to effect the expungement by means of replacing the originally submitted version of the Bingham report with a version that eliminates the pages that are subject to the protective order (pages 57-71). In the present petition, applicant stated that:

i) the replacement copy of the Bingham Report is identical to “the originally submitted document except for the removal of pages 57-71,”

¹ *Square D Company v. EI Electronics, Inc.*, 1:06-cv-5079 (N.D. Ill.)

- ii) the substitute Form 1449 is identical except that the annotation of J91 has been changed to reflect that only specific pages are now included, and
- iii) the removed pages of the Bingham report are not material to patentability.

On April 14, 2010, petitioner applicant supplemented the present petition by a further filing in which petitioner stated that the information is subject to a protective order, the information had not been made public, and petitioner committed to retain the information for the period of the patent.

In view of the terms of the protective order, the irreparable harm to the litigation defendants that would be caused by public disclosure of the protected materials, and the facts and circumstances in this instance, the applicant's petition under 37 CFR 1.182 to replace the document subject to protective order with a version that is not subject to the protective order is granted.

Since the present application has been published, a one-time courtesy copy of this decision is being sent to third party E.I. Electronics.

ADDITIONAL DISCUSSION

This decision does not relieve applicant of the duty to disclose to the Office information applicant is aware of which is material to patentability pursuant to 37 CFR 1.56, regardless of whether the "material" information can be classified as a trade secret, or as proprietary material, or whether it is subject to a protective order. MPEP § 724 sets forth procedures designed to enable the Office to ensure as complete an application or patent file wrapper as possible insofar as "material" information is concerned, while preventing unnecessary public disclosure of trade secrets, proprietary information, and information subject to a protective order. Also, such information can be redacted to the extent deemed appropriate to satisfy the duty to disclose. Should a situation arise where the duty to disclose is in conflict with the protective order (i.e. if the disclosure of protected information would be needed in order to comply with applicant's duty), applicant should approach the court for relief from the protective order.

CONCLUSION

1. The relief requested in the applicant's petition is granted to (a) expunge the August 11, 2009 Bingham report identified as item J91 on the accompanying form 1449 and (b) accept a replacement (submitted April 9, 2010) redacted to eliminate the protected material.
2. The relief requested in the applicant's petition is granted to replace the August 11, 2009 Form 1449 (listing the submitted documents) with the April 9, 2010 Form 1449.
3. As the documents to be expunged have already been made part of the Image File Wrapper (IFW) system and cannot be physically returned, expungement is effected by permanently sealing the documents identified above by closing the documents in the IFW and marking them as non-public.

4. Inquiries regarding the present decision may be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or, in his absence, to Susy Tsang-Foster, Legal Advisor at (571) 272-7711.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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4-20-10